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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/992,882

**Applicant(s)**

DUKIEWICZ ET AL.

**Examiner**

Jason P Salce

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-14,17-51,54-62 and 65-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,17-51,54-62 and 65-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 6/1/04 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 5, 7-14, 17, 19-24, 47-51, 54-62 and 65-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hullinger et al. (U.S. Patent No. 6,442,518) in view of Henmi et al. (U.S. Patent No. 5,390,027).

Referring to claim 1, Hullinger discloses receiving script data for a video program from a production system used in production of the video program (see Figure 3 for receiving a raw closed caption text file (script data) 34 for a video program from a production system used in production of the video program (see receiving the video program from a TV station 12 (production system))). Also note Column 4, Lines 19-42.

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Hullinger also discloses determining identifiers for each of multiple segments of the program (see Column 4, Lines 37-42 for pre-parsing the script data by assigning file identifiers).

Hullinger also discloses creating closed caption data for the program from the script data, the closed caption data comprising text data corresponding to said script data (see Column 4, Lines 37-44 for pre-parsing the script data (raw closed caption text file)), and data provided at locations corresponding to beginnings of each of the multiple segments of the program, the data that corresponds to a segment comprising an identifier of the corresponding segment (see Column 10, Lines 1-11 for each segment of closed caption data having a start and end ID).

Hullinger fails to disclose that the data provided at locations corresponding to beginnings of each of the multiple segments, which also comprises an identifier, is timing data. Henmi discloses timing data provided at locations corresponding to the beginnings of each of the programming events (see Column 6, Lines 14-16 for processing the timing data contained in the data unit, which is from the script data transmitted in the VBI, also note that this timing data includes a start time as described in Figure 1b, which designates the beginnings of each programming event), the timing data corresponding to a programming event comprising an identifier of the corresponding programming event (see Column 8, Lines 6-18 for a description of how the timing data is stored in memory with the corresponding channel (identifier) of a program to be displayed in the program list).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the pre-parser processed closed caption data, as taught by Hullinger, using the timing data, as taught by Henmi, for the purpose of allowing a user to record a program from the closed caption information transmitted in an incoming television signal (see Column 1, Lines 19-22 of Henmi).

Claim 2 corresponds to claim 1, where Henmi discloses that the timing data also contains an end time (see Figure 1b).

Claim 5 corresponds to claim 1, where Henmi discloses providing synchronized transmission of the closed caption data and programming events (see "sync data" in Figure 2b and Column 1, Lines 36-45).

Claim 7 corresponds to claim 1, where Henmi discloses storing the programming events and the closed caption data on a storage medium (see Column 8, Lines 11-18 for storing programming events, such as recording a program and closed caption data (program table data)).

Claim 8 corresponds to claim 1, where Henmi discloses a recording reservation option (identifier), which determines an amount of time by which the identifier precedes the beginning of the programming event (see "Second Flag for Recording Reservation" in Figure 1b and Column 8, Lines 19-22). By using this identifier it is inherent that an amount of time is determined before the program will be recorded, otherwise the system cannot know when the program should be recorded.

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Claim 9 corresponds to claim 1, where Henmi discloses that synchronization (timing) data is inserted before other data in the VBI (see Column 1, Lines 36-45).

Claim 10 corresponds to claim 1, where Henmi discloses that the text broadcast data is transmitted in the vertical blanking interval, which is hidden data in a video signal (Column 1, Lines 36-38).

Claim 11 corresponds to claim 1, where Henmi discloses that the timing data is accompanied by a timing data marker (see start or end time in Figure 1b).

Claim 12 corresponds to claim 1, where Henmi discloses that the timing data is encrypted (see Column 14, Lines 11-13 for disclosing an encoded (encrypted) transmission-format).

Referring to claims 13-14 and 17 and 19-24, see rejection of claims 1-2, 5 and 7-12, respectively.

Referring to claims 47, see rejection of claim 1 and note that closed caption data inherently follows the spoken words of the actor of the video program on a viewer's display.

Referring to claim 48, see rejection of claim 11.

Referring to claim 49, see rejection of claim 12.

Referring to claims 50-51, see rejection of claims 1-2 respectively. The examiner notes that "determining programming events within a program" and "determining identifiers of the programming events" are equivalent to the single limitation of "determining identifiers of individual programming events within the program".

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Referring to claims 54 and 55, see rejection of claim 10.

Referring to claims 56-58, see rejection of claims 7-9, respectively.

Referring to claims 59-60, see rejection of claims 11-12, respectively.

Referring to claims 61-62 and 65-71, see rejection of claims 50-51 and 54-60, respectively.

3. Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hullinger et al. (U.S. Patent No. 6,442,518) in view of Henmi et al. (U.S. Patent No. 5,390,027) in further view of Shriver (U.S. Patent No. 6,290,359).

Referring to claim 6, Hullinger and Henmi teach all the limitations in claims 1 and 5, and also teach a display (UIM 24 in Figure 1 of Hullinger and element 122 of Figure 8 in Henmi). Both inventors fail to disclose that the teleprompter is used to a person who appears in a video program as a reader of the text (for example a newscaster or a person giving a speech at the academy awards using a teleprompter). Shriver teaches using a teleprompter to display to a person being filmed by a camera (therefore, being viewed by others on a television program) his/her script (see Column 7, Lines 21-31). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the displays of Hullinger and Henmi, using the teleprompter, as taught by Shriver, for the purpose of helping an actor or actress remember his/her lines for the play he/she is performing.

Referring to claim 18, see rejection of claim 6.

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4. Claims 25-37 and 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Thong et al. (U.S. Patent No. 5,442,518) in view of Shriver (U.S. Patent No. 6,290,359).

Referring to claim 25, Van Thong discloses producing closed caption data (see Column 1, Lines 20-21). Van Thong also discloses that the closed caption data comprises timing data comprising beginning timing data provided at locations in the closed caption data corresponding to beginnings of program segments (see Column 2, Lines 50-58 for segments of closed caption being synchronized with the audio of a video program) within the video program (see Column 1, Lines 46-48 for a time stamp defining when a caption should appear and disappear). Van Thong also discloses that the closed caption data discloses text data corresponding to at least an audio portion of the video program (see Column 1, Lines 9-15).

Van Thong also discloses producing a video signal for the video program (see use of pre-recorded movies or television programs at Column 1, Lines 28-30).

Van Thong also discloses synchronizing the closed caption data to the video signal in accordance with display of corresponding text by a teleprompter system used in the production of the video program (see Column 1, Lines 9-15 and Column 2, Lines 43-45). Also note that a teleprompter system is analogous to the display used to display the captions in relation to the spoken audio data being presented to a viewer.



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Van Thong fails to teach that the teleprompter system is used by a person who appears in a video program as a reader of the text (for example a newscaster or a person giving a speech at the academy awards using a teleprompter). Shriver teaches using a teleprompter to display an actor/actresses script during the filming of a video program (therefore, being viewed by others on a television program and is during the production of the video program) (see Column 7, Lines 21-31). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the display of Van Thong, using the teleprompter, as taught by Shriver, for the purpose of helping an actor or actress remember his/her lines for the play he/she is performing.

Claim 26 corresponds to claim 25, where Van Thong discloses that the timing data further comprises end-timing data provided at locations corresponding to ends of programming events (see Column 1, Lines 32-34 and Lines 46-48 on displaying a caption for a time period set by the start and end time of an actor speaking (programming event)).

Claim 27-28 corresponds to claim 25, where Van Thong discloses that the caption can be set for a segment of the video program where the actor is speaking (see Column 1, Lines 32-34).

Claim 29 corresponds to claim 25, where Van Thong discloses synchronizing video signal and closed caption data to the client video reception devices (see Column 1, Lines 5-15).

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Claim 30 corresponds to claim 25, where Van Thong discloses storing the synchronized video signal and closed caption data on a machine-readable storage medium (see Column 1, Lines 49-51).

Claim 31 corresponds to claim 25, where Van Thong discloses that the timing data comprises an identifier associated with a programming event of the television program (see Column 1, 46-48 for the time stamp including an identifier (start of caption displaying) with is associated with a programming event).

Claim 32 corresponds to claim 25, see rejection of claim 31 and also notes Van Thong discloses data indicating an amount of time by which the identifier precedes the beginning of the programming event (see Column 1, Lines 36-41 for a description of showing the caption before the actor starts speaking).

Claim 33 corresponds to claim 25, where Van Thong discloses that the timing data is inserted separately from the beginning of the programming event by using transcript data defining when a caption should be displayed (see Column 1, Lines 44-46).

Claim 34 corresponds to claim 25, where it is inherent that data in the closed caption portion of the video signal, which is the first 21 lines of the VBI, is hidden in the video signal (not displayed).

Claims 35-36 correspond to claim 25, where the examiner notes that the MPEP 2106 VI (Determine Whether the Claimed Invention Complies With 35 U.S.C. 102 and 103) states, "Nonfunctional descriptive material cannot render non-obvious an invention that would have otherwise been obvious." (Cf. In re

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Gulack, 703 F2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983). This section further states "a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e. the descriptive material does not reconfigure the computer). The teleprompter is shown to provide an actor or actress with his or her script lines. Simply because the actor appears in a news program, home shopping channel, or an academy award presenter, does not render the invention non-obvious, and therefore, does not distinguish the invention from the prior art in terms of patentability (see again MPEG 2106 IV) because the teleprompter system is still present, and providing the same function among all the different television programs.

Claim 37 corresponds to claim 25, where Van Thong discloses a time stamp for displaying a caption at the proper time (Column 1, Lines 46-48).

Referring to claims 39-45, see rejection of claims 25-37, respectively.

5. Claims 38 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Thong et al. (U.S. Patent No. 5,442,518) in view of Shriver (U.S. Patent No. 6,290,359) in further view of Brothers et al. (U.S. Patent No. 5,799,083).

Referring to claim 38, Van Thong and Shriver disclose all of the limitations in claim 25, but fail to teach that the timing data is encrypted. Brothers teaches the combined video and the closed caption data (all data in the VBI lines) are encrypted by encryption unit 24 (see Column 8, Lines 8-12). At the time invention was made, it would have been obvious to a person of ordinary skill in

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the art, to modify the closed caption data (that includes a time stamp of when to display the closed caption on a teleprompter), as taught by Van Thong and Shriver, using the encryption unit 24, as taught by Brothers, for the purpose of allowing courts, intelligence agencies, new agencies, researchers, journalists, insurance agencies, and others to verify the authenticity of an electronic recording without having to further employ the services of a trusted third party 12 (see Column 8, Lines 36-41 of Brothers).

Referring to claim 46, see rejection of claim 38.

### ***Conclusion***


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 29, 2004

  
CHRIS GRANT  
PRIMARY EXAMINER